

Appl. No. 09/558,922

REMARKS

Claims 32 and 35-43 are pending in the present application. No claims are added, canceled or amended hereby. The remarks below support applicant's assertion that these claims distinguish over the cited prior art, and are in condition for allowance.

35 U.S.C. § 103(a)

Claims 32 and 35-43 were rejected in the Office Action under 35 U.S.C. 103(a) as being unpatentable over Dasan (USP 5,761,662) in view of Furst (USP 6,297,819).

As a brief introduction to applicant's arguments, the claims of the present application are essentially directed to a method for providing content to a user including the step of assembling data which is

- (1) in a format readable by a Web browser program outside of a window of a Web browser program (claim 32, lines 4-5; see also claim 39, lines 4-7),
- (2) wherein the information includes instructions for invoking a computing device resident process (claim 32, lines 5-6; see also claim 39, lines 5-6),
- (3) executable independent of a Web browser (claim 32, line 6),
- (4) and a definition that defines at least in part a functionality and an appearance of a user interface (claim 32, lines 6-7; see also claim 39, lines 8-10).

Appl. No. 09/558,922

Each of these points provided together enable the delivery of a unique data file to a user. The information forming a part of such a file may be displayed not only outside of the frame of a web browser window, but independent of the browser program altogether. Furthermore, the file itself carries data which defines the functionality and appearance of the user interface in which the results process are displayed. The file includes instructions usable by a computing device to present a frame specifically designed for certain content. Data delivered in the file essentially defines the appearance and operation of the frame. One of the key ideas behind this claim is that a user may request a browser-independent display window (i.e., such window specifically designed to display web content outside of a window of a conventional web browser), and by simply identifying and requesting the browser independent display window, operational elements required to render and populate that window may be assembled and transmitted to the computing device. Of course, it is the actual language of the claims on which we must rely, so let us examine the language on a point-by-point basis in light of the cited reference (citation to claim and line numbers provided above).

(1) In a format readable by a Web browser program outside of a window of a Web browser program

First, as to point (1), applicant argues that neither reference discloses or suggests that web content be displayed outside of a window of a web browser program. In applicant's response dated December 30, 2005, it was established that Dasan teaches that a user establishes a profile, which is a list of topics of interest, and a list of web sites at which to look for the topics of interest. The system examines those sites for items containing the identified topics of interest, then presents those items for display in the user's browser window.

Appl. No. 09/558,922

Furst illustrates icons which "span" the scroll bar of a browser window (Furst, vol. 8, lines 43-46). These icons are, therefore, partially within (and form a part of) the browser window - not "outside" the window of the web browser program. (Outside is defined as "on the outer side of; external to; beyond the limit of; not within..., Oxford English Dictionary (Shorter), Oxford university Press, 2002.)

Since neither reference teaches or suggests data displayed "outside of a window of a Web browser program", the combination of the two references cannot teach or suggest that feature. For this reason alone, the claims of the present application are patentably distinct from Dasan and Furst, when considered alone or in combination.

(2) Wherein the information includes instructions for invoking a computing device resident process

As to point (2), again as demonstrated in applicant's response dated December 30, 2005, Dasan performs all functions as server-resident processes (e.g., col. 4, lines 42-44), as opposed to computing-device resident processes. Likewise, according to Furst, all applications operate at remote servers ("a client program...interacts with the ...core servers" col. 2, lines 14-17, and "All data is stored on database servers. Only HTML cookies are placed on the user's computer." Col. 5, lines 33-35.) Through their stated dependence on servers, Dasan and Furst expressly preclude operating applications on the user's computer. Thus, since neither Dasan nor Furst teach the feature that "the information includes instructions for invoking a computing device resident process" (the computing device being the user's computing device per claim 32, line 3) the combination of the two references cannot teach or suggest that feature. Therefore,

Appl. No. 09/558,922

for a second reason, the claims of the present application are patentably distinct from Dasan and Furst, when considered alone or in combination.

(3) Executable independent of a Web browser

As to point (3), the Office Action concedes that Dasan does not teach or suggest that the computing device resident process is executable independent of a Web browser. According to Furst, a program is downloaded and installed on the user's computer (col. 4, lines 42-46). However, this software is coupled to the user's web browser application visually (e.g., Fig. 5) and logically (col. 5, lines 12-20). Among the many statements demonstrating the dependence upon a web browser, Furst states that "[t]he core functionality is provided by one or more servers...and a client program running on the user's computer that interacts with the user's running web browser..." (col. 2, lines 13-17, emphasis added) and furthermore that "[t]he client 124 is essentially a thin shell for an embedded web browser, whose function is to display web pages sent by the System or by component application tools" (col. 4, lines 63-65, emphasis added). Accordingly, neither Dasan nor Furst provide a process executable independent of a Web browser application. Therefore, the combination of those references likewise fails to provide such teaching. Thus, for a third reason, Dasan and Furst, alone or in combination with one another fail to teach or suggest the limitations of claim 32.

Appl. No. 09/558,922

(4) A definition that defines at least in part a functionality and an appearance of a user interface

Finally, with regard to point (4), Dasan teaches the creation of a personalized "newspaper" which is shown as displayed within a rectangular frame in Fig. 11. Items in which a user indicates an interest (1104, 1106, 1008) are listed within the rectangular frame (see col. 8, lines 23 –34). There is nothing stated in the reference about content within the data retrieved which specifies in any way the frame or window format in which that particular data is displayed. One key feature of the present invention is that by obtaining a definition of a window in which data is displayed, the provider of the data or the applications which generate the data can tailor the window for his or her specific data. Once again as previously demonstrated in applicant's response of December 30, 2005, there is no mention therein of the data (e.g., the news sources) including a definition for the frame. And as for the format of the data itself, the system of Dasan converts retrieved news items (which were obtained with a predefined format) into ASCII files (col. 8, lines 4-11), thus dissociating any format the provider originally intended to be associated with the content text.

Likewise, while Furst mentions that the icons 502, 504, 506 may be windows, they may also take other forms, Furst is silent as to where such frame definitions are obtained, how they are modified, etc., and specifically silent as to any teaching or suggestion that any data obtained from a website include information defining a frame for the display of such data. From the teachings of Furst, it appears that the format for the icons are an inherent part of the shell program, and not is any way associated with nor obtained with particular data. Since neither reference teaches or suggests that the information include a definition the appearance of a user interface in which data is displayed, the combination of the two references cannot teach or

Appl. No. 09/558,922

suggest that feature. For this fourth reason, the claims of the present application are patentably distinct from Dasan and Furst, when considered alone or in combination.

As will be appreciated, claim 32, and by their dependence on claims 32, each of claims 35-38, are patentably distinct from Dasan and Furst for at least each of the four reasons discussed above. As the differences demonstrated above are deemed sufficient to distinguish all of claims 32 and 35-38 from the cited references, applicant reserves further discussion of the unique features of claims 35-38 for a later correspondence, if necessary. In addition, claim 39, and by their dependence on claim 39, each of claims 40-43, are patentably distinct from Dasan and Furst for the at least reasons (1), (2), and (4) above. As the differences demonstrated above are deemed sufficient to distinguish all of claims 39 and 40-43 from the cited references, applicant reserves further discussion of the unique features of claims 40-43 for a later correspondence, if necessary. Therefore, on these grounds, applicant respectfully traverses the rejection of claims 32 and 35-43, and requests reconsideration and allowance of said claims.

The combination of Dasan and Furst

The Office Action seeks to combine the teachings of Dasan and Furst in order to demonstrate the obviousness of the claims in the present application. Applicant asserts that making such a combination is improper. In establishing a *prima facie* case of obviousness relying on the combination of two references, the references must disclose a reason or motivation to combine their teachings to make the claimed invention. In re Dillon, 919 F. 2d 688, 692-93, 16 USPQ2d 1897, 1901 (Fed. Cir. 1990)(en banc), cert denied, 500 U.S. 904 (1991). Furthermore, it is not enough to show that there is some abstract motivation for

Appl. No. 09/558,922

combining references. Rather, a person of ordinary skill in the art must be provided some motivation by the references to combine their teachings in the particular manner claimed. In re Koltzab, 217 F.3d 1365, 1371 (Fed. Cir. 2000). "In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination *in the manner claimed*." In re Rouffet, 149 F.3d 1350, 1357 (Fed. Cir. 1998)(emphasis added).

As stated in the Office Action in response to applicant's traverse of a restriction requirement, the claims pending in this application are directed to a method of "retrieving and transmitting information including instructions and definition that define a functionality and an appearance of a user interface." (Office Action, paragraph 2, lines 11-12). Therefore, if the combination of the cited references is proper, one or both references should suggest making such a combination with the goal to obtain such a method.

However, a careful reading of the references does not lead to any such suggestion. In support of the combination, the Office Action makes only the rather cryptic assertion that "It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Furst and Dasan to include the format readable a Web browser program outside of a window of a Web browser program, the computing device resident process executable independent of a Web browser program and the user interface outside of a window of a Web browser program and within which the results of the computing device resident process are presented." (Office Action, paragraph 5, lines, 32-37.) This statement is a conclusion, not a rationale for making the combination of the references. In accordance with Ex parte Garrett, 1986 Pat. App. LEXIS 8, 4 (EPAI 1986), such a conclusion is insufficient to meet

Appl. No. 09/558,922

the burden imposed on the Examiner in Ex parte Levy, 17 U.S.P.Q.2d 1461 (BPAI 1990) to demonstrate, in the first instance, how the prior art suggests and motivates the proposed combination so as to render obvious the claimed invention. Indeed, the Office Action points to no suggestion in either reference motivating their combination nor how they might be so combined.

Dasan is directed to the collection and display of news information from disparate web sites based on a user profile, while Furst is directed to tools to enhance a browsing experience. With all respect for the examiner, these fields of endeavor are not the same. While each may present information accessible by clicking on links, there is where the similarity ends. The newspaper of Dasan autonomously obtains, removes format from, and organizes news items based on user entered preferences, then delivers them for display. The tools of Furst track a users browsing and provide additional features associated therewith. There is no reason one skilled in the art would even consider combining such references.

Accordingly, the references fail to provide any reason for making their combination, let alone how one skilled in the art might do so to obtain the claimed invention. Thus, applicant asserts that the proposed combination of the references is improper and cannot support a finding of *prima facie* obviousness of the claims of the present application.

The Restriction Requirement

Applicant acknowledges the finality of the restriction requirement presented in the Office Action. Claims to the non elected groups (claims 44-47, and 48-57) have been previously cancelled from the present application. However, applicant would like to point out that the basis

Appl. No. 09/558,922

for the finality of the restriction requirement offered in the Office Action is without cited authority, and that applicant's arguments presented in the response of April 6, 2006, have not been fully addressed. The argument presented in the Office Action is essentially that despite the actual language of the claims, the claims may "appear" to be patentably distinct. Again, in support of an argument we find an unsupported conclusion that "patentably distinct embodiments cannot be supported by a single formal design claim." (Office Action, para. 2, line 9.) The Office Action fails to argue how each of the claims in groups 1 and 2 appear to be patentably distinct despite the presence of language to the contrary.

However, the inadequacies of the basis for the restriction requirement notwithstanding, applicant acknowledges that the restriction requirement remains, and therefore does not seek to re-introduce cancelled claims. Furthermore, on this basis, applicant reserves the right to file one or more divisional applications to non-elected claims without prejudice.

Conclusion

For the foregoing reasons, the present application is thought to be clearly in condition for allowance. Accordingly, favorable reconsideration and issuance of a formal Notice of Allowance for this application in light of the amendments and remarks provided above is respectfully requested.

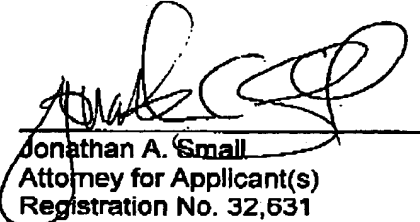
By action taken here, Applicant in no way intends to or causes any surrender of any subject matter or range of equivalents beyond that strictly required to patentably distinguish the claimed invention as a whole over the prior art. Applicant expressly reserves without dedication

Appl. No. 09/558,922

all such subject matter and equivalents that may fall in the range between Applicant's literal claim recitations and combinations taught or suggested by the prior art.

If the Examiner believes that a telephone conference would expedite prosecution and allowance of this application, please telephone the undersigned at 650-941-4470.

Respectfully submitted,



Jonathan A. Small
Attorney for Applicant(s)
Registration No. 32,631

343 Second St., Suite F
Los Altos, CA 94022

Date: October 23, 2006

Telephone: 650-941-4470